

REMARKS

Claims 11-16, 54-59, 89, 90, 96, 97, and 101-104 are pending and under current examination. By this Amendment, Applicants have amended claims 11, 14, 54, 57, 89, 90, 96, and 97. The amendments are fully supported by the originally-filed application. For example, support for the amendments can be found in the specification at p. 23, lines 4-9, p. 24, lines 7-18, and Figs. 11B and 11C. No new matter has been added.

Summary

In the Office Action¹, the Examiner took the following actions:

(a) rejected claims 54-59, 103, and 104 under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter; and

(b) rejected claims 11-16, 54-59, 89, 90, 96, 97, and 101-104² under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,285,777 ("Kanevsky") in view of U.S. Patent No. 7,236,970 ("Winslow").

Applicants respectfully traverse these rejections and request reconsideration and withdrawal of these rejections.

Rejections of Claims under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 54-59, 103, and 104 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Without conceding with the Office Action's allegations, Applicants have amended independent claim 54 to recite "[a] system . . . comprising: a storage device . . . a first obtaining device . . . a sending device . . . a receiving device . . . and a second obtaining device" Applicants have made similar amendments to independent claim 57. Applicants

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

² The Office Action cites "10-104" in item 7, which appears to be a typographical error of "101-104."

respectfully submits that the "system" recited in claims 54 and 57 falls within the machine category of statutory subject matter. Applicants therefore respectfully request withdrawal of the § 101 rejection.

Rejection of Claims under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 11-16, 54-59, 89, 90, 96, 97, and 101-104 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kanevsky in view of Winslow. A *prima facie* case of obviousness has not been established with respect to claims 11-16, 54-59, 89, 90, 96, 97, and 101-104.

To establish a *prima facie* case of obviousness, the Office Action must, among other things, properly determine the scope and content of the prior art and properly ascertain the differences between the claimed invention and the prior art. See M.P.E.P. § 2144.08(II)(A), 8th Ed., Rev. 6 (September 2007). Furthermore, the Office Action must make findings with respect to all of the claim limitations and must make "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." See M.P.E.P. §§ 2143.03 and 2141(III).

Amended independent claim 11 recites "A method, implemented using a computer, for determining a standardized physical address of a user having an electronic account." The method comprising, among other things, the following features:

sending the address of the user to a static address database, the static address database using the address of the user to obtain a delivery point identification key from a master address database that contains the standardized physical address of the user, wherein the standardized physical address conforms to a standard format;

receiving the delivery point identification key from the static address database, the delivery point identification key

containing information specifying a location of the standardized physical address within the master address database; and

obtaining the standardized physical address from the master address database using the delivery point identification key.

According to amended independent claim 11, the "static address database [uses] . . . the address of the user to obtain a delivery point identification key from a master address database that contains the standardized physical address of the user," wherein "the delivery point identification key contain[s] information specifying a location of the standardized physical address within the master address database." The delivery point identification key is received from the static address database, and used to obtain the standardized physical address from the master address database.

In contrast, Kanevsky and Winslow, whether taken alone or in combination, do not disclose at least the above features of the claimed method for determining the standardized physical address.

Kanevsky discloses "[a] communication system that transmits and receives combinations of paper mail and electronic mail." See Kanevsky, Abstract. Kanevsky also discloses that "information about sender/receivers (their e-mail/post addresses) is stored in the database of database server means 38." *Id.*, col. 2, lines 49-51. Kanevsky also discloses a typical e-mail header example, which contains post address information. See *Id.*, col. 2, lines 59-62. In Fig. 5, Kanevsky discloses "a table that illustrates an example of a representation of a sender's instruction and information on an envelope of a letter," where line 124 shows the destination post address included on the envelope of the letter. See *Id.*, col. 6, lines 9-13 and Fig. 5.

Kanevsky, however, does not teach or suggest a “static address database” that uses “the address of the user to obtain a delivery point identification key from a master address database that contains the standardized physical address of the user,” as recited in claim 11. In addition, the “e-mail header” disclosed by Kanevsky does not correspond to the claimed “delivery point identification key containing information specifying a location of the standardized physical address within the master address database,” as recited in claim 11 (emphasis added). Furthermore, Kanevsky does not teach or suggest “receiving the delivery point identification key from the static address database,” as recited in claim 11. Finally, Kanevsky does not teach or suggest “obtaining the standardized physical address from the master address database using the delivery point identification key,” as recited in claim 11.

The Office Action relies on Winslow to allegedly cure the deficiencies of Kanevsky, and alleges that “Winslow discloses creating a static address database from a master address database [col. 1, lines 46-56],” and that it would have been obvious to one of ordinary skill in the art to combine Winslow with Kanevsky. Office Action, pp. 4-5. Applicants respectfully disagree.

Winslow discloses “[a]n address matching system that maintains a central database of valid addresses.” Winslow, Abstract. Winslow discloses a client 16, which “maintains a companion file for each address book with which client 16 interacts.” *Id.*, col. 6, lines 63-65. Winslow also discloses an “Address Identity data member” that is “a key that uniquely identifies the address to which the companion record corresponds in an address book database.” *Id.*, col. 7, lines 21-23. Fig. 3 of Winslow describes an operation of client 16. At step 60, a user selects “a desired destination address from an

address book at client 16." *Id.*, col. 7, lines 48-49. The client 16 then "determines whether there is a corresponding record in the companion file for the selected address . . . by accessing the Address Identity values in the companion file." *Id.*, lines 50-55. If there is no corresponding records in the address book at client 16, the selected address "must be validated through AMS server 12," which is shown in Fig. 2. *See also Id.*, lines 55-58.

In Winslow, the "Address Identity" is stored in the companion file, and is only accessed for determining whether there is a corresponding record for the address selected by the user. Winslow does not teach or suggest "a static address database using the address of the user to obtain a delivery point identification key from a master address database that contains the standardized physical address of the user," as recited in claim 11 (emphasis added). In addition, Winslow also does not teach or suggest "receiving the delivery point identification key from the static address database," as recited in claim 11 (emphasis added). Furthermore, Winslow does not teach or suggest "obtaining the standardized physical address from the master address database using the delivery point identification key," as recited in claim 11 (emphasis added). Therefore, Winslow fails to cure the deficiencies of Kanevsky.

For at least the foregoing reasons, Kanevsky and Winslow, whether taken alone or in combination, fail to teach or suggest the features recited in amended independent claim 11, and the Office Action incorrectly determined the scope and content of the prior art. Moreover, the undisclosed features represent significant differences between the claimed invention and the prior art. Therefore, a *prima facie* case of obviousness has

not been established with respect to claim 11. Claim 11 is therefore allowable over the cited references.

Although of different scope, each of amended independent claims 14, 54, 57, 89, 90, 96, and 97 includes at least one feature similar to those recited in amended claim 11, which is not taught or suggested by Kanevsky and Winslow, whether taken alone or in combination. For example, claim 14 recites "receiving a delivery point identification key from the address database, the delivery point identification key specifying a location of the standardized physical address within the address database; and obtaining the standardized physical address from the address database using the delivery point identification key," which are not taught or suggested by Kanevsky and Winslow, whether taken alone or in combination.

For at least the same reasons claim 11 is allowable, each of independent claims 14, 54, 57, 89, 90, 96, and 97 is also patentable over the cited references, and thus, is allowable. Dependent claims 12, 13, 15, 16, 55, 56, 58, 59, and 101-104 are also allowable at least by virtue of their respective dependence from independent claims 14, 54, 57, 89, 90, 96, and 97, as well as by virtue of reciting additional features not taught or suggested by the cited references. Applicants therefore respectfully request withdrawal of the § 103(a) rejection.

Conclusion

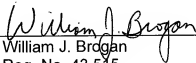
In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

Please grant any additional extensions of time required to enter this response
and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 8, 2009

By: 
William J. Brogan
Reg. No. 43,515
(571) 203-2748